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APR 16 2009

OFFICE OF PETITIONS

In re Application of :
Michael Gauselmann :
Application No. 09/491779 :
Filing or 371(c) Date: 01/26/2000 :
Attorney Docket Number: :
ADP231 : ON PETITION

This is a decision on the Petition to Withdraw Holding of Abandonment Under 37 CFR § 1.181, filed February 23, 2009.

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

A non-final Office action was mailed December 31, 2007. Applicant filed an Amendment in response to the Office action on April 4, 2008, and Supplemented the Amendment on April 30, 2008. The Amendment and Supplement were non-compliant. Applicant was so notified in a Notice of Non-Compliant Amendment, mailed June 18, 2008. The Notice set a one (1) month period for reply, and provided for extensions of time under 37 CFR 1.136(a). Applicant filed an Amendment in response to the Notice on July 21, 2008. The Amendment was again non-compliant. Applicant was so notified in an Office communication, mailed October 16, 2008. The Office communication informed Applicant that the Amendment filed July 21, 2008 was not fully responsive to the Notice mailed June 18, 2008. The Office communication set no new period for reply, but instead informed applicant that "[i]n no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date set forth in the Office action. A fully responsive reply must be timely filed to avoid abandonment of this application."

Applicant filed an Amendment in response to the Office communication on November 19, 2008. The Amendment was again non-compliant. No complete and proper reply to the Notice of Non-Compliant Amendment, mailed June 18, 2008, having been filed, the application became abandoned July 19, 2008.

The Office mailed a Notice of Abandonment on February 6, 2009. The Notice of Abandonment indicated as the reason for abandonment Applicant's failure to file a proper reply to the Notice of Non-Compliant Amendment, mailed June 18, 2008, noting the numerous non-compliant amendments filed by Applicant.

The present petition

Applicant files the present petition and acknowledges that the reply filed February 13, 2008 contained "informalities," but asserts that the informalities in no case prevented or interfered with potential evaluation of claims 1, 3 and 86 on the merits. Applicant also argues that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance as per 37 CFR 1.111(b), could have been made by Applicant in connection with any of the noncompliant amendments filed April 4, 2008; April 30, 2008 and July 21, 2008. Further to this, Applicant avers, the three informalities found in the Amendment filed November 19, 2008 could certainly be considered objections or requirements as to form.

Applicant also argues that the Office communication mailed October 16, 2008 was not a rejection of Applicant's claims as stated in the Notice of Abandonment, and Applicant urges that the reply of November 19, 2008 was a proper reply, or at least a bona fide attempt at a proper reply.

Applicant asseverates that the November 19, 2008 amendment was in response to the Office communication, which for the first time required Applicant to mark all changes relative to the set of claims filed September 17, 2007. The "request" of the Office communication of October 19, 2008 was, Applicant avers, in the form of a general instruction and without pointing out of individual errors needing and/or correction proposals." Petition at p.9. Petitioner frames the holding in the Notice of Abandonment, that the reply filed November 19, 2008 is not a bona fide attempt at a proper reply, is deemed to be administrative arbitrariness in view of the length of the amendment and changed or new status of 82 claims plus additional claim changes. Petitioner cites to the MPEP Section 711.03(c), which states:

> When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

Applicant asserts that the holding of abandonment is harsh in view of three informalities found by the examiner within an extensive and bona fide amendment of November 19, 2008.

Applicable Law, Rules and MPEP

35 U.S.C. § 133, Time for prosecuting application, states:

> Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR 1.135, Abandonment for failure to reply within time period, provides that

> (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
> (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment. (Emphasis supplied).
> (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission. (Emphasis supplied).

MPEP 711.03(c)

Analysis and conclusion

Initially it is noted that it is Applicants responsibility in the first instance to file a complete and proper reply as the condition of the application requires. Here, Applicant failed to file a complete and proper reply as the condition of the application required. Applicant filed replies to non-final Office action on April 4, 2008; April 30, 2008; July 21, 2008 and November 19, 2008; however, none of the replies were both complete and proper as the condition of the application required.

Applicant refers to 37 CFR 1.135(b), and argues that a bona fide attempt to advance the application was filed and thus Applicant should have been given a new time period for reply; however, the Rule and MPEP make clear that the Examiner MAY consider a bona fide reply adequate. In this instance, after Applicant filed replies to the Office action on April 4, 2008, April 30, 2008, and July 21, 2008, the Examiner mailed an Office communication on October 16, 2008. The Office communication informed Applicant that the Amendment filed July 21, 2008 was not fully responsive to the Notice mailed June 18, 2008. The Office communication set no new period for reply, but instead informed applicant that "[i]n no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date set forth in the Office action. A fully responsive reply must be timely filed to avoid abandonment of this application." The Examiner placed Applicant on Notice that the application would become abandoned unless a fully responsive reply was filed within the time period set forth in the Notice of Non-Compliant Amendment mailed June 18, 2008.

The MPEP, in discussing petitions to withdraw the holding of abandonment, makes clear that "[e]vidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); Krahn v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Applicant argues that the November 19, 2008 amendment was in response to the Office communication, which for the first time required Applicant to mark all changes relative to the set of claims filed September 17, 2007, and that the "request" of the Office communication of October 19, 2008 was in the form of a general instruction and without pointing out of individual errors needing and/or correction proposals. However, Applicant may not shift the burden of Applicant's failure to file a complete and proper reply to the Office action to this Office's alleged failure to inform Applicant of deficiencies in his replies. It is Applicant's responsibility to file a complete and proper reply to the Office action as the condition of the application requires. Applicant, a registered practitioner, is tasked with knowledge of Office laws, rules of practice and the MPEP.

The MPEP's discussion on revival of an application based upon unavoidable proves instructive. Section 711.03(c) states"

Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay. See Haines, 673 F. Supp. at 317, 5 USPQ2d at 1132; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). For example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not "unavoidable" when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. (Emphasis supplied).

Applicant's petition has been considered. The petition to withdraw the holding of abandonment is dismissed.

Alternate venue

Applicant is strongly urged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee.

The filing of a petition under 37 CFR.1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
Derek L. Woods
Attorney
Office of Petitions